

ATTORNEY'S DOCKET NO.: 2002850-0015 (S99-142)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Jain, et al.	Examiner:	Do, Pensee T.
Serial No.:	09/923,752	Group Art Unit:	1641
Filed:	August 7, 2001		
For:	DEVICES AND METHODS TO FORM A RANDOMLY ORDERED ARRAY OF MAGNETIC BEADS AND USES THEREOF		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TRANSMITTAL OF RESPONSE TO RESTRICTION REQUIREMENT

In response to the Restriction Requirement mailed by the U.S. Patent and Trademark Office on January 12, 2005, enclosed herewith please find the following:

1. Response to Restriction Requirement (3 pages); and
2. Return Postcard

Additionally, please charge any further fees associated with this filing or apply any credits to our Deposit Account No. 03-1721.

Respectfully submitted,

Monica R. Gerber, M.D., Ph.D.
Reg. No. 46,724

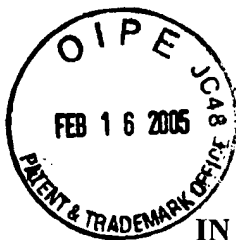
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Dated: February 14, 2005

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For Patents, P.O. Box 1450, Alexandria, VA 22313

on 2-14-05
Janetia Saccoccia



1641
JFW

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Sir:

09 2-14-05
Sandra Saccoccia

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Restriction Requirement mailed 1/12/2005, Applicants elect Group I, claims 1-68, with traverse. Various grounds of traversal are set forth below. The fact that certain potential grounds of traversal are not presented here should not be taken to mean that Applicants agree with the Examiner's reasoning with respect to any aspect of the Restriction Requirement including, but not limited to, the Examiner's characterization of the invention, methods of making or practicing the invention, or alternatives thereto.

The Examiner has assigned claims 1-68, drawn to a device for forming an array of magnetic particles, to Group I and has assigned claims 74-77 and 79-82, drawn to a method of forming an array of magnetic particles, to a separate group (Group III). The Examiner has stated that the process, i.e. a method for forming an array of magnetic particles, can be practiced by another materially different product. However, Applicants respectfully submit that the Examiner appears to have overlooked the precise wording of MPEP § 806.05(e), which states that "Process and apparatus for its practice can be shown to be distinct inventions, if ... the process *as claimed* can be practiced by another materially different apparatus or by hand." (emphasis added). Applicants submit that the process *as claimed* in claims 74-77 *requires* the use of the device of claims 1, 59, or 63. The Examiner's attention is drawn to claim 74, which recites, "A method for forming an array of magnetic particles comprising: contacting the device of any of claims 1, 59,

or 63 with a plurality of magnetic particles”. Applicants respectfully request reconsideration of the assignment of claims 74-77 to Group III and request reassignment of these claims to Group I.

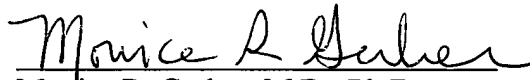
The Examiner has assigned claims 86-109, drawn to a method of analyzing a sample, to Group IV. The Examiner has stated that the invention of Group IV is unrelated to the invention of Group I on the ground that the inventions are not capable of use together and have different modes of operation, different functions, or different effects. Applicants respectfully submit that the inventions of Group I and Group IV are capable of use together. For example, the device of Group I may be used to form an array of magnetic particles having probes attached thereto. The array may be used in the practice of the method of claims 86-109. See, for example, claim 86, which recites “forming an array of magnetic particles”. The Examiner has stated that the method of invention IV does not require the use of a substrate with magnetic regions. However, the question of whether the method of invention IV requires the use of a substrate with magnetic regions is not the issue. Applicants submit that one of the uses for the device of Group I is to form an array of magnetic particles that may be used to practice the method of claims 86-109. Therefore the inventions are capable of use together in an integrated process in which the device is used to form an array of magnetic particles which is then used to analyze a sample.

The Examiner appears to have relied on MPEP § 806.04(a) in assigning claims 86-109 to a separate group from that of claims 1-68. Applicants respectfully direct the Examiner’s attention to MPEP § 806.04(b), which is more relevant to the instant claims since they involve a device (i.e., an apparatus) and a method (i.e., a process). MPEP § 806.04(b) states, “Where the two inventions are process and apparatus, and the apparatus *cannot be used* to practice the process *or any part thereof*, they are independent.” (emphasis added). Here, in contrast to the situation described in MPEP § 806.04(b) in which restriction is appropriate, the apparatus *can* be used to practice a part of the process, i.e., to form an array of magnetic particles as recited in claim 86. Applicants therefore respectfully request reconsideration of the assignment of claims 86-109 to Group IV and request reassignment of these claims to Group I.

Applicant thanks the Examiner for careful consideration of this case. Should any questions arise in connection with this Response to Restriction Requirement, the Examiner is invited to telephone the undersigned.

In view of the fact that Feb. 12, 2005, was a Saturday, the instant response is believed to be timely filed and thus no fees should be due. However, please charge any fees that may indeed be associated with this matter, or credit any overpayments, to our Deposit Account No. 03-1721.

Respectfully submitted,

A handwritten signature in cursive script, reading "Monica R. Gerber".

Monica R. Gerber, M.D., Ph.D.

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